

O-051-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 81470  
BY CISA S.p.A. FOR A DECLARATION OF INVALIDITY  
IN RESPECT OF TRADE MARK No. 2220673  
IN THE NAME OF CO-OPERATIVE INSURANCE SOCIETY LIMITED**

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by CISA S.p.A. for a declaration of Invalidity in  
respect of Trade Mark No. 2220673 in the name  
of Co-operative Insurance Society Limited**

### **BACKGROUND**

1. Registration Number 2220673 is in respect of the following series of four trade marks:

cis  
CiS  
Cis  
CIS

2. The mark is registered for the following specifications of goods and services in Classes 6, 9, 19, 20, 35, 36, 37 and 42:

#### **Class 06**

Metal locks; metals doors; parts and fittings for the aforesaid goods.

#### **Class 09**

Alarms; electric locks; electric security devices; parts and fittings for the aforesaid goods.

#### **Class 19**

Windows; window fittings; parts and fittings for the aforesaid goods.

#### **Class 20**

Doors; door fittings; parts and fittings for the aforesaid goods.

#### **Class 35**

Sales promotion services; the provision of advice regarding the sale of financial/insurance goods and services; marketing services; business advice and business administration services.

#### **Class 36**

Insurance services; financial services; possessions insurance; valuables insurance; goods in transit insurance; freezer insurance; freezer contents insurance; buildings insurance; mobile home insurance; vehicle insurance; motor insurance; towed-vehicle insurance; cycle insurance; motorcycle insurance; commercial vehicle insurance; motor boat insurance; yacht insurance; small craft insurance; travel insurance; sporting insurance; sports equipment insurance; life insurance; health insurance; personal accident insurance; personal liability insurance; employer's liability insurance; farm insurance; working animal insurance; horse insurance; pet insurance; farmer's

insurance; hotelier's insurance; shopkeeper's insurance; electioneering insurance; special events insurance; insurance for training and development schemes; re-insurance; insurance broking; claims processing; claims handling; claims investigation; advising on insurance claims; loss adjusting; investment activities; investment services; fund management activities; fund management services; property investment; dealing in equities; arranging transactions in equities; arranging custody of equities; providing custody of equities; advising concerning equities; dealing in collective investment schemes including unit trusts; arranging transactions in collective investment schemes including unit trusts; arranging custody of collective investment schemes including unit trusts; providing custody of collective investment schemes including unit trusts; advising concerning collective investment schemes including unit trusts; establishing collective investment schemes including unit trusts; administering collective investment schemes including unit trusts; dealing in fixed income securities; arranging transactions in fixed income securities; arranging custody of fixed income securities; providing custody of fixed income securities; advising concerning fixed income securities; dealing in instruments entitling to or representing securities; arranging transactions in instruments entitling to or representing securities; arranging custody of instruments entitling to or representing securities; providing custody of instruments entitling to or representing securities; advising concerning instruments entitling to or representing securities; dealing in options and futures; arranging transactions in options and futures; arranging custody of options and futures; providing custody of options and futures; advising concerning options and futures; dealing in contracts for difference and currency exchange derivatives; arranging transactions in contracts for difference and currency exchange derivatives; arranging custody of contracts for difference and currency exchange derivatives; providing custody of contracts for difference and currency exchange derivatives; advising concerning contracts for difference and currency exchange derivatives; investment products; savings products; life insurance policies; assurance policies; endowment policies; endowment mortgages; pensions; pension contribution schemes; bonds; annuities; unit trusts; collective investment schemes; tax-efficient investment schemes including Personal Equity Plans and Individual Savings Accounts; financial products; repayment mortgages; interest only mortgages; secured loans; loans; bank accounts; deposit accounts; instant access savings accounts.

**Class 37**

Property construction services; vehicle repair services.

**Class 42**

Computer services; legal services; printing services; property management services.

3. The mark stands registered from a filing date of 29 January 2000 and was placed on the register on 10 August 2001.
4. On 16 October 2003 CISA S.p.A. applied for the invalidation of the trade mark registration on the following grounds:

- (i) Under Section 47(2)(a) of the Act because the applicant is the proprietor of an earlier registered trade mark which is similar to the registered proprietor's trade mark and the registered proprietor's mark should be declared invalid in respect of:

“metal locks, metal doors, parts and fittings for the aforesaid goods” in Class 6,

“alarms; electric locks; electric security devices; parts and fittings for the aforesaid goods” in Class 9,

“window fittings; parts and fittings for windows and window fittings” in Class 19,

“door fittings; parts and fittings for the aforesaid goods” in Class 20,

“sales promotion services; marketing services; business advice and business administration services; all relating to security systems; locks, padlocks and keys” in Class 35,

as these goods and services are identical or similar to those goods covered by the applicant's following earlier registration and there is a likelihood of confusion on the part of the public.

<b>TRADE MARK REGISTRATION No.</b>	<b>MARK</b>	<b>EFFECTIVE DATE</b>	<b>SPECIFICATION OF GOODS</b>
823868		4 August 1961	Class 6 – Locks, padlocks and keys

- (ii) Under Section 47(2)(b) because there is an earlier right in relation to which the condition set out in Section 5(4) is satisfied, in particular Section 5(4)(a) in that use of the mark in suit in respect of those goods and services in Classes 6, 9, 19, 20 and 35 (set out above) is liable to be prevented by the law of passing off.

5. The Registered Proprietor filed a Counterstatement denying the grounds of invalidity.

6. The applicant filed evidence and both parties forwarded written submissions for the Hearing Officer's attention. Both parties ask for an award of costs in their favour.

7. The parties are content for a decision to be taken without recourse to a hearing.

#### **APPLICANT'S EVIDENCE**

8. This consists of a witness statement by Roy McCawley dated 13 February 2004. Mr McCawley is a Director of CISA (UK) Plc, a subsidiary company of the applicant.

9. Mr McCawley stated that the applicant's registered mark has been used in the UK, substantially in the form in which it was registered, since 1975 and goods carrying the mark have been sold in the UK since that date. He adds that goods on which the mark have been used include the following: padlocks; mortice locks; cylinders for locks; panic bars; electric and electronic locks; keys. At Exhibit RMY1 to his statement, Mr McCawley provides a schedule of product sales, a copy of which is attached as Annex One to this decision.

10. Mr McCawley goes on to advertising and promotion and details promotional expenditure in relation to this mark as follows:

1994	1995	1996	1997	1998	1999
£8671	£7078	£7860	£12142	£16448	£24960

11. Mr McCawley explains that the strategy of the applicant has been one of promotion by personal contact rather than by advertising and additionally, the figures do not include advertising and promotion by retailers. He adds that while the above figures are not excessively high they nevertheless represent a considerable presence, in promotional terms, within a tightly knit industry.

12. Mr McCawley states that the applicant's mark was publicised in relation to the products for which it is registered at a number of exhibitions in the United Kingdom between the years 1992 and 2000. In support he refers to Exhibit RMY2 to his statement which is a list of these exhibitions with places and dates. Also Exhibit RMY3 details his company's exhibits at the Independent Hotelier 1998 Exhibition, together with a letter confirming the participation of his company. Furthermore, to Exhibit RMY4 contains a swatch of photographs showing his company's stand at the Hospitality Show in February 1999 and Exhibit RMY5 contains a swatch of photographs depicting his company's stand at Hotelympia in January 2000.

13. Mr McCawley states that advertisements have been placed, inter alia, in GS Magazine, the Essential Product guide for Hotels and Restaurants, Architectural Profile, Hotels Magazine, Glass and Glazing, National Merchant Banks Society, Hardware Buyers Guide, Building Update, Construction Magazine, Hotel, Product Information Review, the British Hotel and Catering and Institutional Purchasers Data Base, and Architectural Ironmongery Journal. Exhibit RMY7 to Mr McCawley's statement contains a swatch of such advertisements and publicity material. Exhibit RMY7 also shows a mouse mat and an excerpt from an article in the December 1999 issue of Hotel & Restaurant.

14. Mr McCawley goes onto draw attention to Exhibit RMY8 to his statement which comprises copies of a CISA Catalogue for the UK for August 1999 and an Architectural Ironmongers Net Price list for the year 1999, together with a number of

informative CISA booklets and leaflets which describe the products. All these items carry the CISA Trade Mark. In addition, Exhibit RMY8 contains a CISA catalogue from the year 1980, showing the original form of the mark as registered and depicting a number of examples of products carrying that same mark. He next refers to Exhibit RMY9 to his statement which contains examples of packaging and labels, showing use of the CISA mark.

15. Mr McCawley also refers to Exhibit RMY10 to his statement a swatch of orders from outside companies for CISA products.

16. Mr McCawley goes on to make a number of submissions in relation to the issue of similarity and the likelihood of confusion.

17. In relation to the applicant's reputation, Mr McCawley refers to the following Exhibits to his statement:

- (i) Exhibit RMY13 – a 1997 list of hotels throughout the world (including 83 in Great Britain) using CISA locks and safes;
- (ii) Exhibit RMY14 – a swatch of letters sent to the applicant by well-known international hotel chains, praising the applicant's products and concerning the use of the products.
- (iii) Exhibits RMY15 – a booklet about the history of the applicant.

18. Mr McCawley draws attention at Exhibit RMY18 to the result of a search which has been carried out for all trade marks covering the UK either applied for or registered in Classes 6 and 9 and beginning with the letters CIS. He concludes that on the date the search was carried out (November 2001) there were no other marks, either registered or applied for in these classes which covered either locks or other security products and which began with the letters CIS. In Mr McCawley's view this demonstrates that it cannot be argued by the Registered Proprietor that there are a number of existing marks similar to the mark CISA and covering locks and other security products. Apart from the marks of the Registered Proprietor, there is no other mark, covering the UK and beginning with the letters CIS, which is applied for or registered in respect of locks and security products except the registrations of the Applicant.

## **APPLICANT'S WRITTEN SUBMISSIONS**

19. The applicant's written submissions are attached to a letter dated 5 November 2004 from Fry Heath Spence, the applicant's professional advisors in these proceedings.

20. The applicant points out that the registered proprietor has not pleaded that there is any difference between the four marks that form the series for the purposes of these proceedings.

21. In relation to the comparison of marks the applicant states that it wishes to concentrate on three forms of reasonable and fair use and makes the following comments in paragraphs 9 to 18 of its submissions:

***“CISA word vs. CIS word***

The first is the form in which this mark will inevitably be used in communication. The word CISA appearing in the centre is a prominent part of the mark and is the only part that can be enunciated or typed. When referred to while speaking, or by telephone, or by email or other electronic communication, the mark will be referred to as “CISA”, IE THE WORD. This is, of course, the phonetic appreciation called for by *Sabel v Puma*.

This is not to say that all word and device marks given automatic rights to the word included therein. Each case will stand on its merits, taking into account the absolute levels of distinctiveness of the word element and the device element, and where the balance of distinctiveness lies. In this case, the word is very much more distinctive, and the inherent distinctiveness of the lozenge (etc is not overwhelming. *Sabel v Puma* calls for use to bear in mind, in particular, the distinctive and dominant components. Accordingly, the recollection of the potential purchaser presented with the mark will be of the word element.

This comparison, of the words CISA and CIS is straightforward. RMY18 confirms that there are no other marks registered in or in respect of the UK, in the industry sector concerned, which start with the CIS- element. Mr McCawley confirms that he is not aware of any other trade marks prefixed CIS used in the UK for locks and security products, evidence that the proprietor chose not to challenge.

CISA and CIS differ only in the absence of the final letter ‘A’. It is instructive to consider whether the applicant’s mark would be allowed were the situation reversed; ie would CISA be regarded as dissimilar to a cited CIS? We think not. This leads to the conclusion that the marks are similar. Furthermore, it is well established that the initial parts of the mark are the most memorable; in this case the mark in question is identical to that very part of the applicant’s mark. Again, this leads to a conclusion of similarity.

Mr McCawley gives evidence at several points in his witness statement (paragraphs 15, 16, 18 and 26) to the effect that he considers the marks to be similar and that confusion is likely. The proprietor has chosen not to contest this evidence. No evidence as to non-similarity or unlikelihood of confusion has been offered; not even a simple witness statement by a person in their capacity as a potential customer.

***CISA device vs. CIS device***

The second form of reasonable and fair use is that of the CISA device as set out above, and the CIS mark presented within a similar border. If the registration is maintained, then the proprietor will in practice be permitted to

use the mark in whatever manner it thinks fit. This includes use within reasonably simple border styles, such as that of the CISA device.

Again, the only difference will be the absence of the final ‘A’ and the presence of the non-distinctive suffixes. Our comments at paragraphs 11 to 13 are repeated.

***CISA device vs. CIS word***

The third form of reasonable and fair use if, of course, the CIS mark as registered and the CISA device as registered.

In this case, there is an additional point of difference in that the applicant’s mark includes the ellipse and lozenge devices. However, as noted above, the word CISA appearing in the centre is a prominent part of the mark and is the only part that can be enunciated or typed. When referred to while speaking, or by telephone, or by email or other electronic communication, the mark will be referred to as CISA. Thus, the imperfect recollection of the potential purchaser who saw the CISA device mark would be that she or he had been offered CISA-branded products. The level of distinctiveness which may or may not be held by the lozenge (etc) will not be enough to outweigh the inherent distinctiveness of the CISA word. As noted above, it is the distinctive components that are (*inter alia*) to be particularly borne in mind in line with *Sabel v Puma*.

It is interesting in these cases to ponder what part of the applicant’s mark led to the examiner’s decision to allow the application when it was made in 1961. Whilst we can only surmise we doubt that it was the lozenge border that so impressed the examiner.”

22. Turning to the comparison of goods in paragraphs 32 and 33 its written submissions and services the applicant states that:

“This can be summarised as:

<p>Metal Locks</p> <p>Parts and fittings for metal doors</p> <p>Electric locks</p> <p>Electric security devices (in the form of electric locks)</p> <p>Window fittings</p> <p>Parts and fittings for windows and window fittings</p> <p>Door fittings</p>	<p>Identical to: “Locks”</p>
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Parts and fittings for doors and door fittings.	
Metal doors	Similar to: "Locks"
Parts and fittings for metal locks	
Alarms	
Electric security devices (other than electric locks)	
Parts and fittings for alarms, electric locks and electric security devices	
Sales promotion services, marketing services, business advice and business administration services; all relating to security systems, locks, padlocks and keys.	

23. In relation to Section 5(4)(a) the applicant claims that the scale of its use has been significant and has had a significant impact and that as the respective marks are similar, confusion would result.

24. On costs, regardless of the outcome the applicant submits that the Registrar's normal scale is appropriate.

**REGISTERED PROPRIETOR'S WRITTEN SUBMISSIONS**

25. The registered proprietor's written submissions are attached to a letter dated 4 November 2004 from Wilson Gunn M'Caw, the registered proprietor's professional representatives in these proceedings.

26. In relation to the comparison of the marks, the registered proprietor makes the following points:

**“Visual Comparison**

Visually the proprietor's mark consists of three letters in various cases. The letters are not stylised in anyway, nor are they combined with any form of logo or device.

The applicant's mark consists of 4 letters in a highly stylised format within a diamond shaped device. Although the letters making up the proprietor's mark are contained in the applicant's mark, the additional elements of the applicant's mark, namely the stylisation, the device and the letter 'A', render the marks visually distinct from one another.

### **Aural Comparison**

The proprietor's mark would be pronounced as CIS ie. three separate letters. The proprietor is a well known and long established organisation in the UK, and we submit that the public would recognise the mark as being an abbreviation of the proprietor's name and consequently would pronounce the marks as 3 separate letters rather than as a word (SIS or KIS).

The applicant's marks would either be pronounced as four separate letters CISA, or as a word CISA, but we submit it would be referred to in normal speech as "the CISA logo".

### **Conceptual**

Neither mark has a meaning in the English language, but we submit that each mark directly refers to its respective proprietor ie. to Co-operative Insurance Society and to CISA SpA. We submit that, although the marks have limited conceptual meaning, if anything they direct the consumer to think of two entirely different company names.

We conclude that the visual, aural and conceptual dissimilarities outweigh any similarities between the marks and the marks are therefore not confusingly similar."

27. Turning to the goods at issue, the registered proprietor submits:

#### **"Comparison of the goods**

The applicant's goods of the registration are "locks, padlocks and keys", and the additional goods on which they claim to have used the marks are "security systems". The goods and services of the registration which are the subject of the invalidity application are those in Classes 6, 9, 19, 20 and 35. In respect of Classes 6 and 9, it is of course admitted that "metal locks" and "electric locks" are identical or similar goods to "locks".

Taking into account the criteria for the comparison of goods and services outlined in the case of *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 we submit that none of the other goods and services of the registration are identical to or similar with the applicant's goods.

There is no similarity whatsoever between the Class 35 services of the registration and the applicant's goods."

28. On the Section 5(4)(a) ground, the registered proprietor denies that the applicant possesses goodwill in its mark and stated that all the marks are not similar, there is no misrepresentation.

29. The registered proprietor requests a full award of costs as negotiations on a possible settlement were broken off by the applicant and the registered proprietor has been put to the expense at preparing and filing submissions.

30. This completes my summary of the evidence and submissions filed in these proceedings. I now turn to the decision.

## DECISION

31. Firstly I go the Section 5(2)(b) ground. Section 5(2) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

32. An earlier right is defined in Section 6, the relevant parts state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

33. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, and *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

34. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) account should be taken on the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*.

35. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection for such a mark. The applicant has filed evidence relating to the use of its CISA trade mark. While the evidence confirms use of the mark as registered (and also in other formats) and provides information on the turnover of goods sold, it provides no evidence of the applicants market share or the extent of its reputation. Given the very large market for the goods for which the mark is registered – locks, padlocks and keys – it seems to me that the turnover details provided may not indicate a particularly high market share and do not enable me to infer that the applicant has an especially great reputation under the mark. Furthermore, expenditure on the marketing and promotion of the mark while significant is by no means remarkable and there are no details as to the extent of the circulation of the catalogues and advertising material referred to in the evidence. I would add that no supporting evidence from third parties or the trade has been filed.

36. On the evidence filed, I have no doubt that the applicant possesses goodwill and a not insignificant reputation in its earlier mark. However, it has not been shown to be a household name amongst the relevant public.

37. The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchen QC sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion.”

38. In the present case it seems to me that the opponent’s earlier mark on a balance of its reputation and inherent nature is fully distinctive and deserving of a wide penumbra of protection. In my view CISA would be perceived as an invented word by the relevant customer and it is not a word which has a reference to the goods at issue.

39. In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, and/or services the category of goods and/or services in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the registered marks and the applicant’s earlier registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services within the respective specifications.

40. In its evidence the applicant has drawn attention to the results of a search of the UK Trade Marks Register in Classes 6 and 9 in respect of marks beginning with the letters CIS. This amounts to no more than ‘state of the register’ information and is of no real assistance – *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281. My decision involves a comparison of the applicant’s and registered proprietor’s particular marks and must be made on its own merits.

41. I now go on to a comparison of the registered proprietor’s goods with the applicant’s goods and services.

42. In determining whether the services covered by the application are similar to the goods covered by the earlier trade mark I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (pages 296, 297) as set below:

“The following factors must be relevant in considering whether there is or is not similarity:

- (a) the respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in the trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors.”

43. Whilst I acknowledge that in the view of the CANON-MGM- judgement by the European Court of Justice (3-39/97) the *Treat* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods.

44. In its written submissions the registered proprietor sensibly concedes that its metal locks in Class 6 and electronic locks in Class 9 are identical and similar to those goods encompassed within the specification of the applicant’s earlier registration. It denies that there is similarity between its remaining goods in Classes 6 and 9 or in respect of the relevant Class 19, 20 and 35 goods and services.

45. In relation to Class 6 the applicant claims that metal doors, parts and fittings are similar to its locks, padlocks and keys in Class 6. It seems to me that doors and locks may share the function of keeping property secure and are often purchased at the same time (as a package) through the same outlets eg specialist supplier/installer or D.I.Y retailers. Nevertheless, a door has more general additional functions and the manufacturers of doors and locks are usually different specialist undertakings. Doors and locks are complementary goods and are therefore similar to some degree. However, I do not, on balance, believe them to be closely similar. The general public would not necessarily believe that the goods emanated from the same business undertaking. In relation to parts and fittings for metal doors it is my view that a lock may well be described as a part or fitting for a door. I conclude that the registered

proprietor's Class 6 specification covers identical and similar goods to those falling within the specification of the applicant's earlier registration.

46. Turning to Class 9, the applicant submits that alarms, electric security devices and parts and fittings for those goods are similar to its goods. I have no doubt that the description 'electric security devices' encompasses 'electric locks'. Accordingly these goods and their parts and fittings are similar to the applicant's locks in Class 6. While 'alarms' are security apparatus it seems to me that they are normally supplied and purchased separately from locks, through different specialist suppliers, or in D.I.Y. outlets through different 'departments' or sections of the store. In my view "alarms" are not similar to "locks, padlocks and keys" but if I am wrong any similarity is very slight. I do not believe that the customer would perceive these particular goods as emanating from the same source.

47. Regarding Class 19 the applicant claims that "window fittings; parts and fittings for windows and window fittings" are similar to its goods. Goods in Class 19 are essentially in the nature of building materials e.g. glass, and would not encompass locks. In my view window fittings or parts therefor in Class 19 are not similar to the applicant's goods.

48. Going to Class 20, the applicant submits that "door fittings, parts and fittings for doors and door fittings are similar to those goods within in its earlier registration. Locks (not of metal) fall within Class 20 and it seems to me that a door lock could easily be described as a part or fitting for a door. Accordingly, these goods are similar to the metallic locks included within the applicant's specification of goods.

49. Finally, the position regarding the Class 35 services where the applicant submits that "sales promotion services marketing services; business advice and business administration services; all relating to security systems, locks, padlocks and keys" are similar to its goods - "Locks, padlocks and keys" (the underlined words have been added to the specification as registered by the applicant). The Class 35 specification, as registered, contains no limitation as to use and it seems to me that sales promotion, marketing, business advice and business administration services are specific, specialised business activities in their own right and it is somewhat strained to link these activities to the particular goods and claim similarity. In my view, in the absence of evidence to the contrary, the relevant public would not be likely to associate a business carrying out the services specified with a manufacturer/supplier of particular goods.

50. I now go to a comparison of the respective marks.

51. The registration in suit comprises a series of four trade marks – essentially the three letters CIS which, in my view, would be seen as an invented word.

52. Unsurprisingly, the registered proprietor does not make separate submissions in respect of the individual marks comprising the series. However, it does submit that the mark(s) would be perceived as three separate letters, as opposed to a word, by virtue of the registered proprietor's reputation. No evidence of reputation has been filed by the registered proprietors and even if I were to take judicial notice of reputation it would only be in relation to "insurance services" and not to the goods

and services at issue in these proceedings. In my view CIS (and its variations) is/are likely to be perceived as an invented word in relation to the relevant goods and services. There is no separation or punctuation between the letters, to invite the customers to a different perception.

53. The applicant's earlier mark comprises the four letters CISA, making an invented word, on a light oval background within a four sided "diamond" shaped device. As mentioned earlier in this decision, this is a highly distinctive mark deserving a wide penumbra of protection.

54. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in my comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstance of trade. I must bear this in mind when making the comparisons.

55. I go to a visual comparison of the respective marks. The word CISA incorporates CIS (the registered proprietor's mark) in its first three letters. It differs in that it contains an additional letter - its final letter, the letter A. Furthermore, the applicant's mark is presented within a background device. While this device is a prominent and noticeable element of the mark, it seems to me that the word CISA is the dominant, distinctive element of the mark as a whole. Notwithstanding that differences exist, it is my view that as the registered proprietor's mark shares the first three letters of the prominent four letter word within the applicant's mark, overall visual similarity exists between the marks as a whole. The beginnings of words are, in general, more noticeable to the eye than their terminations, particularly in the context of highly distinctive invented words.

56. In relation to an aural comparison of the marks, it has long been held that in such comparisons "words speak louder than devices" and in this regard the significance of the background device to the applicant's registration is reduced. It seems to me that the applicant's mark would be described as CISA (pronounced SISA) and the registered proprietor's mark CIS (pronounced SIS). Dictionary words commencing with the letters CIS are invariably pronounced SIS eg cist, cistern, cistercian. While the word CISA contains an additional syllable, this is balanced by the fact that this difference is at the less noticeable termination of the word, rather than its commencement. Notwithstanding this difference, the aural similarity that does exist means that, in my view, there is overall aural similarity in light of the highly distinctive nature of the dominant word element within the applicant's mark and the degree of commonality.

57. Next a conceptual comparison of the marks. As both marks contain invented words (the applicant's mark also containing a not readily describeable device element) they do not possess a clearly defined conceptual identity. However, both marks contain invented words which share the letters CIS (the registered proprietors mark and the first three letters and hence a prominent part of the applicant's four letter word). Accordingly, there is some conceptual similarity overall, given the highly

distinctive nature of the invented word within the applicant's mark and the degree of commonality.

58. The judgements of the European Court of Justice mentioned earlier in this decision make it clear that in my comparisons I must take into account the average customer for the goods and services, the category of goods and services in question and how they are marketed.

59. The customer for the relevant goods e.g. locks, door fittings etc is the public at large as well as the trade, whereas the registered proprietors Class 35 services appear to be directed at the trade. The relevant goods are sold/available through a wide variety of outlets and at a wide range of prices. In my view both the respective goods and services would be purchased with a good degree of care (which mitigates against confusion) but may be purchased on an infrequent basis, often following recommendation (which means imperfect recollection may prove a factor).

## CONCLUSIONS

60. On a global appreciation taking into account all the relevant factors, I have come to the following conclusions:

- (i) the applicant's earlier trade mark is fully and highly distinctive and is deserving of a wide penumbra of protection;
- (ii) those goods and services of the registered proprietor, as specified by the applicant, in Class 20 and Class 6 are identical or similar to those goods encompassed within the specification of the applicant's earlier registration, as are electronic locks, electronic security devices and parts and fittings for those goods in Class 9.
- (iii) the registered proprietor's "alarms" in Class 9 and the Class 19 goods and Class 35 services are not similar to those of the applicant;
- (iv) the registered proprietor's marks are visually, aurally and conceptually similar to the applicant's earlier registered mark;
- (v) while the nature of the goods and services means that the customer would be relatively discerning, the degree of similarity between the goods of the applicant and the goods/services of the registered proprietor, together with the degree of similarity between the respective marks is such that, in all the circumstances, there is a likelihood of confusion in relation to:
  - a) "Metal locks" and "parts and fittings for the aforesaid goods" in Class 6;
  - b) "electric locks", "electric security devices", "parts and fittings for the aforesaid goods" in Class 9";

- c) “door fittings” and “parts and fittings for the aforesaid goods” in Class 20;
- (vi) but no likelihood of confusion exists in relation to “metal doors” in Class 6 and “alarms” in Class 9 as any degree of similarity in the goods is slight.

61. The application for invalidation under Section 5(2)(b) is successful except insofar as it relates to “metal doors” in Class 6, “alarms” in Class 9, the Class 19 goods and the Class 35 services.

62. In reaching this decision I have borne in mind that account should be taken of the highly distinctive character of the earlier mark and that the average customer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture he/she has kept in his/her mind.

### **Section 5(4)(a)**

63. Next, the Section 5(4)(a) ground.

Section 5(4)(a) states:

“5 (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

64. The law on the common law of passing off is clearly set out by Geoffrey Hobbs QC, acting as the ‘Appointed Person’, in *Wild Child* [1998] 14 RPC 455:

“A helpful summary of the element of an action for passing off can be found in Halsbury’s Laws of England 4<sup>th</sup> Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the marks and are known by some distinguishing feature:
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public or believe that goods or services offered by the defendant are goods or services of the plaintiff; and

- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

The restatement of the elements of passing off in the form of this classical trinity has been referred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the fact before the House."

65. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action of passing off where there has been no direct misrepresentation generally requires the presence of two factual elements;

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the Plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective field of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

66. Thus, to succeed in a passing off action, it is necessary for the applicant to establish that at the relevant date (i) they had acquired goodwill under this mark, (ii) that use of the registered proprietor’s mark would amount to a misrepresentation likely to lead to confusion as to the origin of their services, and (iii) that such confusion is likely to cause real damage to goodwill.

## **GOODWILL**

67. In my considerations under Section 5(2)(b) I found that the applicant has a reputation in relation to locks, padlocks and keys. I have no doubt that it possess sufficient goodwill to launch a passing off action.

## **MISREPRESENTATION**

68. While the application possesses a reputation in relation to locks, padlocks and keys, it seems to me that following the decision reached in relation to Section 5(2), the Section 5(4)(a) ground places it in no stronger position. There is no obvious stronger connection between those remaining goods and services which the applicant disputes and those for which the opponent possesses a reputation.

69. To succeed in relation to the relevant goods and services the applicant has to show that the relevant public will believe that these goods and services provided by the registered proprietor are goods and services of the applicant.

70. I have already compared the applicant’s and registered proprietor’s trade marks and found them to be similar. It is well established that in the law of passing off there is no limitation in respect of the parties’ field of activity. Nevertheless, the proximity of an applicant’s field of activity to that of the registered proprietor is highly relevant as to whether the acts complained of amount to a misrepresentation.

71. In essence the question I have to address is whether the relevant public seeing the registered proprietor’s mark used on the remaining Class 6 goods (metal doors) and Class 9 goods (alarms) and the Class 19 goods and Class 35 services would be likely to believe the goods and services were being offered by the opponent. In *Harrods v Harrodian School* [1997] RPC 697, Millet LJ states:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”.

72. In the recent case of *South Cone v Jack Bessant, Dominic Greensmith, Kenny Gary Stringer (a partnership)* 16 May 2001, HC 2000 APP 00617, Pumfrey J in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1939 Act (\*see *Smith Hayden (OVAX)* [1946] 63 RPC 97 as qualified by *BALI* [1969] RPC 473). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

73. I do not consider that the applicant has discharged the onus of showing that the necessary misrepresentation required by the tort of passing off will occur in relation to metal doors in Class 6, alarms in Class 9, the Class 19 goods and the Class 35 services. The application for invalidation under Section 5(4)(a) fails.

## **OUTCOME**

74. The application for invalidity has partially succeeded under Section 47(2)(a) of the Act and Section 47(5) applies. Consequently, the specifications of the mark in suit will be amended by the removal of the following:

- (i) “metal locks” and “parts and fittings for the aforesaid goods” from the Class 6 specification;
- (ii) “electric locks; electric security devices;” from the Class 9 specification;
- (iii) “door fittings; parts and fittings for the aforesaid goods” in Class 20;

## **COSTS**

75. As both sides have achieved a measure of success it seems to me appropriate that I make no order as to costs in these proceedings. In relation to the submissions of the registered proprietor on this point (see paragraph 29 of this decision) I would only comment that there is no obligation on the applicant to resolve the issue through

negotiation and there is no evidence that the applicant has conducted itself in an unreasonable or disproportionate manner. In the event, the applicant has been partially successful in these proceedings.

**Dated this 28<sup>th</sup> day of February 2005**

**JOHN MACGILLIVRAY  
For the Registrar  
the Comptroller-General**

**The Appendix is not attached.**